

REMARKS

The Examiner is thanked for courtesies extended during a telephonic conversation with Applicants' representative, the undersigned, May 26, 2005.

Applicants respectfully request that the Office notes the new attorney docket no. (61040-0018-US) for the subject application and updates their records with the same.

Applicants have considered the Notice of Allowability, and accompanying remarks, mailed March 3, 2005 in connection with the above-identified patent application and respectfully request entry of the instant Amendment and remarks to the file history thereof.

Printing Errors in Patent Application Publication U.S. 2002/0061539 A1

The subject application published as U.S. Patent Application Publication U.S. 2002/0061539 A1 ("the '539 publication"). Applicants remind the Examiner of remarks presented in their November 18, 2002 amendment in the instant application, wherein attention was drawn to a significant printing error in the '539 publication. Specifically, pages 98 through 167 inclusive are duplicates of pages 28 through 97 inclusive, and have been printed in error. Thus, pages 98 through 167 inclusive should be deleted in their entirety as and when a patent issues from the instant application.

Applicants had not previously requested republication of the application under 37 C.F.R. § 1.221(b) to correct this error. Accordingly, since the application has now been allowed and the issue fee is being paid herewith, Applicants respectfully request that the Examiner brings the printing error to the attention of the issue branch at such time as the file is dispatched to issue. The Examiner's attention to this matter is gratefully appreciated.

Color Drawings

Applicants also respectfully draw the Examiner's attention to color drawings to replace Figures 5, 12-16, and 18, in compliance with 37 C.F.R. §§ 1.84(a)(2), and 1.17(h), and a petition for acceptance thereof, all of which filed on even date herewith.

Formal Drawings

Applicants also respectfully draw the Examiner's attention to formal drawings to use in place of Figures 6, 7 - 11, and 17 (as originally numbered), all of which filed on even date herewith.

Applicants submit that neither the color drawings nor the formal drawings, as filed herewith, introduce new matter into the specification, and entry thereof is respectfully requested.

Drawings

The Examiner is thanked for explaining her objections to specific drawings in full. These objections are addressed as follows.

Regarding Figure 7, a replacement figure showing the amendment filed November 18, 2002, is submitted herewith accompanying a transmittal of formal drawings, split into Figures 7a and 7b. The specification has been appropriately amended herein to take account of the revised figure numbering.

Figure 8 has also been replaced by a two-page figure, labeled figures 8a and 8b, as submitted herewith accompanying a transmittal of formal drawings. Applicants amend the specification herein to take account of the revised figure numbering. In respect of the Examiner's comments regarding figure legend and brief description of Figure 8, Applicants make the following observations. First, in the figure as filed herewith, the shading has been improved to distinguish the various bars. Second, with the figure split across two pages, it is expected that the difference between the two portions of the figures is clear. Finally, Applicants amend the specification at pages 31–32 to reference the respective portions of the figure. In essence, Applicants believe that the meaning of the figures, in conjunction with the Brief description on page 6, and the further description on pages 31–32, would be apparent to one of ordinary skill in the art. Specifically, Figure 8 (like Figure 7) references binding assays between GST-GRIP1 constructs that have various configurations of NR-boxes 1, 2, and/or 3 and, separately, the receptors TR and GR. The comparisons in both Figures 8a and 8b (as presented herein) show that such constructs bind differently to TR and GR. The difference between Figures 8a and 8b arises as follows. Figure 8a compares the respective bindings of GST bound to GRIP1 (563-767) and GST bound to an extended GRIP1 (563-1121) with both TR and GR (see specification, page 31, lines 33–34). Figure 8b, however, compares the respective bindings of GST bound to various versions of GRIP1 with different NR-box (“Nrb”) configurations, with both TR and GR (see specification, page 32, lines 10–15). Accordingly, it is respectfully submitted that one of ordinary skill in the art would understand the differences between the two portions of Figure 8 as filed in conjunction with the specification as filed and therefore that insertion of references to two portions of Figure 8 by amendment herein would not constitute new matter.

In respect of Figure 9, Applicants thank the Examiner for pointing out the omitted SEQ ID NO's. The amended version of Figure 9 (presented as two sheets) includes the appropriate SEQ ID NO's. Applicants have also amended the specification, where it refers to Figure 9 to reflect the revised labeling of the panels. It is respectfully pointed out that the description of Figure 9 at page 32 of the specification as filed also references the sequences disclosed in the figures both by sequence and SEQ ID NO and thus that there should be no ambiguity. Additionally, Applicants amend the paragraphs on page 32 that describe Figure 9 to correct several grammatical errors (omission of "with").

Regarding Figure 10, Applicants provide herewith a replacement figure, split into three sheets (Figures 10a, 10b, and 10c) that addresses the Examiner's objection. The specification has been appropriately amended herein to take account of the revised figure numbering. Applicants also draw the Examiner's attention to various amendments to Figure 10 (and the accompanying description in the specification) that take account of discrepancies between residue identification in the figure and the numbering in both the specification and the sequence listing for the instant application. Applicants respectfully submit that such discrepancies had not been appreciated before it became necessary to review Figure 10 in the light of the Examiner's comments presented with her Notice of Allowance. Thus, it is appropriate to present such amendments concurrent with payment of the issue fee. Furthermore, no new matter is introduced by such amendments.

Finally, regarding the Examiner's request to supply a new copy of Figure 11, such a copy, split into three sheets (Figures 11a, 11b, and 11c), is submitted herewith accompanying a transmittal of formal drawings. The specification has been appropriately amended herein to take account of the revised figure numbering.

Amendments to the Claims

With this Amendment, Applicants amend claim 31 to correct the term "atomic coordinates", which finds no antecedent basis in claim 1, by replacing it with "atomic structural model". No new matter is introduced by the Amendment herein, which is merely ministerial in nature and was only appreciated by Applicants upon review of the instant claims as allowed, prior to payment of the issue fee, and, accordingly, entry thereof is respectfully requested.

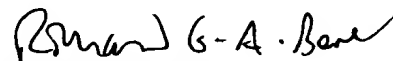
CONCLUSION

In view of the above remarks, Applicants respectfully submit that the subject application is in good and proper order to proceed to issue. If, in the opinion of the Examiner, a telephone conference would resolve any outstanding matters not heretofore resolved, the Examiner is encouraged to call the undersigned at (650) 843-4000.

No fee is believed owed in connection with filing of this amendment under Rule 312, other than the issue fee and petition fee authorized on the accompanying transmittals. Nevertheless, should the Commissioner determine otherwise, he is authorized to charge any underpayment or credit any overpayment to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 61040-0008 US) for the appropriate amount. A copy of this sheet is attached.

Respectfully submitted,

Date: June 3, 2005


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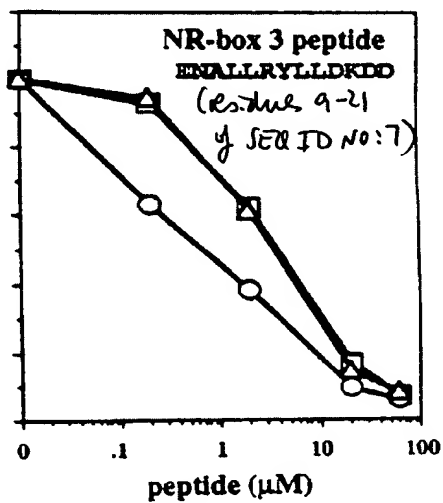
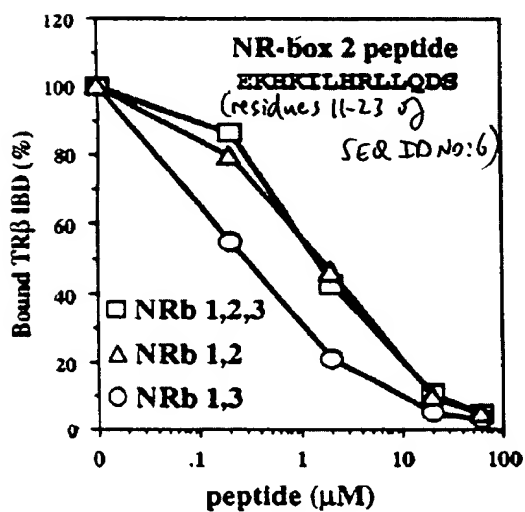
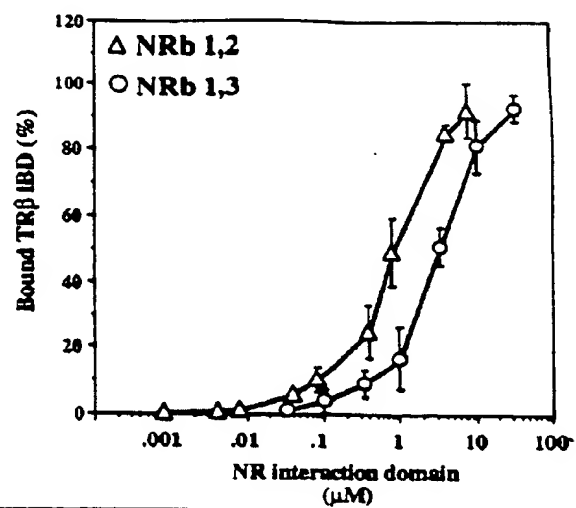
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IN THE DRAWINGS

Marked- up versions of FIGs. 9 and 10 showing the changes in red, follow this page:



ANNOTATED MARK-UP

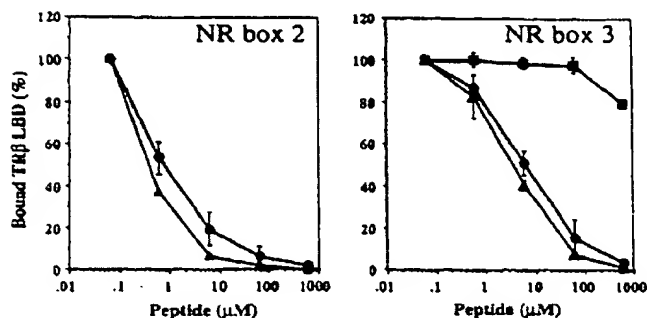
FIGURE 9




ANNOTATED MARK-UP

FIGURE 10

residues 11-23 —●— KKKK  QDS —■— LLRYLL
 residues 7-24 —▲— TSLKEKHK  QDSS —▲— KENA LLRYLL DKDDTKD
 Of PKKCKENA LLRYLL DKDDTKD
 Of SEQ ID NO: 6 kb Of SEQ ID NO: 7



5-24
 residues 80-27 of SEQ ID NO: 7
 residues 1-27 of SEQ ID NO: 6
 SEQ ID NO: 29

PKKCKENA LLRYLL DKDDTKD
 TSLKEKHK  QDSS
 TSLKEKHK LLRYLL QDSS

